

Application Number: 09/884,600

Docket Number: 10011123-1

REMARKS

Upon entry of this Response, claims 1-24 remain pending in the present application. Claims 1, 8, 15, and 22 have been amended. Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

In item 2 of the Office Action, claims 1-3, 8-10, 15-17, and 22-24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,714,968 issued to Prust (hereafter "*Prust*"), further in view of U.S. Patent No. 5,826,269 issued to Hussey (hereafter "*Hussey*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rlickaert, 9F.3d 1531, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicants assert that the cited references fail to show or suggest all of the elements of claims 1-3, 8-10, 15-17, and 22-24. Accordingly, Applicants request that the rejection of these claims be withdrawn.

To begin, amended claim 1 recites as follows:

1. A document retrieval method, comprising:
 - receiving a request email message from a requesting device via a network, the request email message embodying a document request;
 - determining from the request email address whether a destination address on the network to which at least one document specified in the document request is to be sent is a third party address or an originator address on the network, the originator address being associated with the requesting device;
 - automatically generating a forwarding email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the third party address, the forwarding email message being addressed to the third party address;
 - automatically generating a reply email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the originator address on the network, the reply email message being addressed to the originator address; and
 - automatically transmitting either the forwarding email message to the third party address or the reply email message to the originator address on the network in response to the request email message. (Emphasis added).**

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As set forth above, claim 1 as amended specifies that either the forwarding email message to the third party address or the reply email message to the originator address on the network in response to the request email message.

With respect to claims 1, 8, 15, and 22, the Office Action states as follows:

"However, Prust did not explicitly state determining from the request email address whether a destination address on the network to which at least one document specified in the document request is to be sent is a third party address or an originator address on the network, the originator address being associated with the requesting device; and automatically generating a forwarding email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the third party address, the forwarding email message being addressed to the third party address.

In an analogous art of email systems, Hussey disclosed and electronic interface for a network server in which clients send email requests and an email response builder generates a response email message, with an attached document, to be issued to the originator of the corresponding email address as well as any other "copied" email accounts originally designated in the "cc:" field (Hussey, col. 11, lines 55-67, col. 12, lines 1-10).

Both Prust and Hussey provide emailing systems where users request data. Hussey goes into further detail of the standard functions of the emailing systems.

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate the basic functionalities of an email system as taught in Hussey into Prust to provide users with a system that processes user requests for shared resources administered by the server (Hussey, col. 3, lines 30-40)." (Office Action, page 3).

Admittedly, *Hussey* describes the concept of generating a reply email address to a request that is sent to both the email address of the originating device as specified in the "From" field of the request, and any addresses noted in the "CC" field. However, once again Applicants assert that *Hussey* fails to show or suggest the concept of determining whether a response to a document request is to be transmitted to a third party address or an originator address on a network as claimed in amended claim 1. Rather, all addresses to which a response is to be sent are provided in the email request, and no decision need be made as to whether one address or another is to be employed in sending the documents as described in claim 1. Thus, *Hussey* describes a conventional approach where a reply email is created and sent to the address in the "TO" field and any addresses indicated in a "CC" field. However, the present invention involves the creation of systems and

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methods that make the distinction of whether a reply email is to be sent to the originator address, or a forwarding email is to be sent to a third party address. Hussey fails to show or suggest at least this element, as well as other elements as argued in the previous Response filed on 2/1/2005.

In addition, where the structure or text of prior art suggests something other than the instant invention, then it teaches away from the invention, and ultimately, does not suggest the creation of the invention. *Akzo N.V. v U.S. Intern. Trade Comm.*, 808 F.2d 1471, 1 U.S.P.Q 2d (Fed. Cir. 1986), cert. denied, 482 U.S. 909. In this respect, *Hussey* teaches away from the concept of making the determination as to whether an originator address in the "From" field or a specified third party address is to be employed to send a document in response to a received document request. *Hussey* teaches the use of all addresses in the request and avoids the complications of determining specifically where the document is to be sent. Thus, *Hussey* teaches away from making a decision as to whether the originator address is to be employed in a reply or a third party address is to be employed in a forwarding email to send the requested documents to the desired location.

In view of the foregoing, Applicants request that the rejection of claim 1 be withdrawn. In addition, Applicants request that the rejection of claims 8, 15, and 22 be withdrawn for the same reasons discussed above with reference to claim 1. Also, Applicants request that the rejection of claims 2, 3, 9, 10, 16, 17, 23, and 24 be withdrawn as depending from claims 1, 8, 15, or 22.

In addition, claims 4, 11, and 18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust* in view of *Hussey* and further in view of U.S. Patent No. 6,084,952 issued to Beerman, Jr., et al. (hereafter "*Beerman*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9F.3d 1531, 28 U.S.P.Q 2d 1955, 1956 (Fed. Cir. 1993). Applicants assert that the cited combination of *Prust*, *Hussey* and *Beerman* fails to show or suggest each of the elements of claims 4, 11, and 18 as depending from claims 1, 8, and 15.

Accordingly, Applicants request that the rejection of claims 4, 11, and 18 be withdrawn for the same reasons described above with respect to claims 1, 8, and 15.

Next, claims 5, 12, and 19 have been rejected under rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust* in view of International Patent Publication No. WO 01/33874 by Cho, et al. (hereafter "*Cho*"). Applicants respectfully assert

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that the cited combination of *Prust* and *Cho* fails to show or suggest each of the elements of claims 5, 12, and 19, as depending from claims 1, 8, and 15 for the reasons described above. Accordingly, Applicants request that the rejection of claims 5, 12, and 19 be withdrawn as depending from claims 1, 8, and 15.

Next, claims 6, 7, 13, 14, 20, and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust*, *Cho*, and U.S. Patent No. 6,212,268 issued to Nielsen (hereafter "*Nielsen*"). Applicants assert that the cited combination of *Prust*, *Cho* and *Nielsen* fail to show each of the elements of claim 6, 7, 13, 14, 20, and 21 as depending from claims 1, 8, or 15. Accordingly, Applicants request that the rejection of claim 6, 7, 13, 14, 20, and 21 be withdrawn for the same reasons described above with respect to claim 1, 8, and 15.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,


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